



# TODAY

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Stop by the USPTO booth (#114/115) at the International Trademark Association's annual conference in San Francisco, May 7-9, 2001.



*Nicholas P. Godici  
Acting Under Secretary of Commerce for Intellectual Property and  
Acting Director of the United States Patent and Trademark Office*

At the ceremony in which Donald Evans was sworn in as Secretary of Commerce, he told the President that “[w]e look forward to leading the Administration’s e-commerce efforts to foster growth in our knowledge-based economy by our activities at NTIA, NIST, PTO, EDA, and the MBDA.” As he has become more familiar with the activities of these agencies, he has found out that the USPTO has already taken enormous strides in fulfilling the leadership commitment he made to President Bush at that time. E-commerce and e-government have been a vital aspect in the development of the USPTO over the last few years. And in this agency that is based on creative dynamism, the Trademark Operation has been in the forefront of these efforts. The vital importance of trademarks to the business community has been well-served by the programs in the USPTO that are taking full advantage of cutting-edge technology to make the Trademark Operation the epitome of a successful e-government organization. The electronic trademark filing system has been recognized repeatedly for excellence in the use of technology and in the service it provides to the public. I wish to add my congratulations to those who have bestowed kudos on the Trademark Operation.

As you read this publication - either in hard copy or electronic form - you will find that the articles focus on two areas. The first is the Trademark Operation’s many achievements in the area of e-commerce and e-government. The second is the organization’s commitment to constant improvement in the area of customer service. And why is it so important to this agency to take the lead in e-government and to assure that its customers are getting the best service possible? It is because the people who make up this operation realize the importance and value of trademarks to their specific customers and in the marketplace in general.

In a dynamic economy such as ours that is subject to sometimes unpredictable swings into positive and negative territories, trademarks stand out as a reassuring constant. They have been called the fingerprints of commerce and fingerprints are never-changing. This is not to say that trademarks are stagnant or invariable. In fact, the ability of trademarks to mutate into new expressions of old standards is what makes them so valuable to their owners. They are never-changing in the sense that they continue to survive and flourish regardless of the current position

of the economic barometers.

In boom times, trademarks are important to new, start-up businesses as well as the concerns that have existed for decades. A new business must create its public image quickly and powerfully and the most efficient tool for doing this is the development of an effective trademark. An ongoing entity must ensure that its place in a flourishing economy is secure and the trademarks of these businesses are instrumental in that process. When consumers see familiar trademarks, they know and trust that the product or service behind that mark is consistent with past experiences with that trademark. It makes it easy for them to secure a tried and true product or service in the overwhelming panoply of products and services that come into existence in vibrant economic times. New or old, enterprises rely on public recognition of their trademarks to create their presence in the business world.

In an economic downswing, the importance of trademarks may be different, but no less significant. Trademarks are the shorthand of the advertising world. A well-recognized and well-established trademark does not require expenditure of advertising dollars that would otherwise be needed to keep or bring a product or service into consumer consciousness. And effective trademarks become even more important to new business during economic times like this. A well-developed trademark campaign can help a new concern find an advantageous niche in the market place quickly. There are no real downswings in the world of trademarks.

And where does the United States Patent and Trademark Office fit into this dynamic world of trademarks? The Trademark Operation of the USPTO is the guarantor of the value of these marks. A trademark registration issued by the USPTO is one of the most powerful tools an entity can have in protecting its image, its success and, sometimes, its very existence in the business community. It is difficult to place a value on the legal presumptions that flow from a federal trademark registration. They are so effective that sometimes a simple letter backed by a federal registration can deter expensive litigation. If litigation becomes unavoidable, presenting a federal registration in court can be one of the strongest factors in bringing about the registration owner's success. In recent years, the USPTO has received approximately 300,000 applications for trademark registration each year. Based on this figure, the business community clearly realizes that obtaining a federal trademark registration is an important factor in the economic health of a commercial entity.

It is difficult to truly put a clear value on trademarks. There are complex formulas for ascertaining the monetary value of a trademark for the purpose of financial business records. But whatever that figure may be, the real value of trademarks exceeds any dollar amount that a mathematical formula could assign to it. How would you value your own personal name? Trademarks are to businesses as your own name is to yourself. In short, they are beyond value.

# FOREWORD

*from the Commissioner for Trademarks*

Anne H. Chasser  
Commissioner for Trademarks



Welcome to the second annual Special Edition of the USPTO TODAY on Trademarks. We are going e-government! In fact, we are charging ahead. As Acting Under Secretary Godici described this office, we are becoming “the epitome of a successful e-government organization.”

We have accomplished much with the help of our customers and employees. Over the course of the last year, the Trademark Organization has followed its overarching, strategic goal of driving toward an e-government operation. There are two things that are key to this goal, and they are reflected in the list of trademark business goals listed at the end of this issue. Excellent customer service and outstanding employee satisfaction not only help us fully implement e-government, they also result from our e-government initiatives. E-government benefits everyone, because it makes us more efficient and effective.

You will see examples of this in the pages that follow. Trademark Services has done phenomenal things in improving the quality of our products and services. For example, the time from filing to mailing out filing receipts has dropped from 107 days to just nine. At the same time, we are meeting our customer service measures in all areas of trademark services.

Miles Alexander expresses the Trademark Public Advisory Committee’s support for the Trademark Organization. The committee has encouraged strongly trademarks to continue in its efforts to use electronic filing.

There are articles on the successful rollout in Chicago of our outreach program to educate corporations and individuals about e-commerce at the USPTO, on efforts to improve our electronic filing system by seeking input from customers, and on the enforcement activities of our Office of Legislative and International Affairs, whose role has taken on new meaning in a borderless and electronic world.

We also want to share with you some stories about our most important asset...our staff. The profiles of the dynamic deputy commissioner for examination policy, and the fine attorneys recognized by the American Intellectual Property Law Association bring me back to something I said in the first special trademark edition: When an organization is as fortunate as the USPTO in terms of human resources, all it needs to ask is “how high can we reach?” We look forward to working with you.

*Anne H. Chasser*

# E-Commerce at the USPTO... Reaching Out to Our Customers

*by Craig K. Morris and Rachel Wallace, Office of the Commissioner for Trademarks*

**I**n a popular movie of a few years ago, “A Field of Dreams,” a farmer kept hearing a voice (the inimitable James Earl Jones) saying, “If you build it, they will come. If you build it, they will come.” The farmer built a baseball diamond in his cornfield, and indeed, the biggest players of the past came.

Well, what if the USPTO built a trademark electronic filing site, but the biggest filers did not come? We couldn’t very well just sit back and say that James Earl Jones had somehow given us bad advice. No, instead we would need to find out from our customers how the site could better meet their needs, and then make appropriate enhancements. Indeed, that is the beauty of a Web site that it is dynamic and can be updated fairly easily.

We recognize that this is a time of unprecedented challenge, not only for the USPTO, but also for its customers. It is also one of rare opportunity. We must face these challenges together and help each other make the most of the tremendous opportunities that the new e-commerce environment presents to all of us.

The USPTO is determined not just to meet these challenges, but to do so in a way that will improve both quality and customer service. Our goal is not simply to change, but to make things better. To do so, it has become more and more apparent that we must successfully transition from paper-based processing and examination to electronic-based processing and examination. Although the current paper system functioned well in a marketplace that was limited by time and distance to defined places, to accommodate the emerging 21<sup>st</sup> century global marketplace that is unconstrained by time and distance, the USPTO must change how it does business.

We clearly recognize that it is our responsibility to deliver a system that promotes an efficient, effective, and timely process for the examination of trademark applications, a system that is more reliable than what we currently provide, and one that we can easily



**2001: The Trademark Office Goes E-Commerce**  
*sponsors and presenters...*

*front row: Kathryn Barrett Park and Nanette M. Norton.  
middle row: Dolores K. Hanna, Anne H. Chasser, and  
Mickie Voges Piatt.*

*back row: Jerome Gilson, Craig K. Morris, and Robert M.  
Anderson.*

modify in response to the valuable feedback of our customers. This is one of our primary goals in the design of our electronic filing system: to meet the needs of our customers.

To reach out to our customers, we have developed an interactive program to explain the agency's plans for a full transition to e-commerce in the Trademark Operation, with the goal of ensuring that our customers' business needs are met in this new e-commerce environment. On February 16, 2001, in Chicago, Illinois, representatives of the USPTO met with the Chicago trademark community in what may be the first of many similar events around the country.

*Bob Anderson presents the "USPTO E-Commerce Strategy for the Future."*

*Bob Anderson, Kathryn Barrett Park, and Dolores Hanna facilitate "Corporate Discussion Session."*



The USPTO presentations were part of a unique collaboration among IIT Chicago-Kent Law School, which hosted the event, and Dolores K. Hanna of Bell, Boyd & Lloyd, LLC, and Jerome Gilson of Brinks Hofer Gilson & Lione, who sponsored the event. Also sponsoring the program were the Intellectual Property Law Association of Chicago (IPLAC), the Chicago Bar Association Patent, Trademark and Copyright Committee, DePaul University College of Law, the John Marshall Law School, and Northwestern University School of Law.

Over 250 trademark practitioners from Chicago and as far away as Ann Arbor, Michigan, and Indianapolis, Indiana, attended the three-hour program, "2001: The Trademark Office Goes E-Commerce." After introductions by Dolores Hanna, Commissioner of Trademarks Anne H. Chasser and Deputy Commissioner for Trademark Operations Robert M. Anderson made presentations. Commissioner Chasser focused on the top 10 reasons why the USPTO must move to e-commerce and electronic filing of all trademark forms, including improving customer service and the quality of input into the trademark databases; handling continued increases in trademark filings; and lowering pendency. Deputy Commissioner Anderson showcased the future of the Trademark Operation in an e-commerce work environment. The themes of these presentations clearly were change and the future of the USPTO.

Craig K. Morris, manager for trademark business process reengineering at the USPTO, gave a demonstration of the agency's Trademark Electronic Application System (TEAS).



**Craig Morris demonstrates TEAS with customer-suggested improvements.**

**Commissioner Chasser meets and greets program participants during break.**



This demonstration highlighted both the enhancements that have been made since the initial introduction of TEAS, in response to the feedback received from our customers, plus prototypes of changes currently being developed, including:

- Downloadable blank initial application form, which allows creation of a “template” to permit stored information for multiple filings by the same applicant (currently available);
- Links to other resources from within the application form, e.g., the USPTO Manual of Goods and Services (currently available);
- “Bug report” mechanism, to alert USPTO staff to technical problems (currently available);
- “Text” form, which is a narrative format of the application data; i.e., the data is converted from the entries in the data fields to a client-friendly, easy-to-read format (currently available);
- TEAS FAQs, a posting of the most frequently-asked-questions about electronic filing (currently available);
- Forms for all Intent-to-Use and Post Registration filings (currently available);
- Assignment of filing dates based on when the filing arrives on the USPTO server, regardless of whether that date is a Saturday, Sunday, or federal holiday (currently available);
- Text Form e-signature method, by which a completed form can be sent directly to the proper signatory via e-mail, avoiding the more complex method of downloading a completed portable form currently offered (prototype);
- Text Form attachment of a conventional “pen-and-ink signature,” by which a client could sign a completed form in the traditional manner, for the attorney to then create an image file to attach to the electronic version of the form, for submission to the USPTO via the Internet (prototype); and
- E-check payment method, which would allow a customer to include a check number that could be used in reconciling payments to specific serial numbers (prototype).

Two interactive sessions, with in-house corporate trademark counsel and law firm practitioners, followed the USPTO presentations. Kathryn Barrett Park, trademark counsel for General Electric Company, Dolores Hanna, and Bob Anderson facilitated the corporate session, and Nanette Norton and Jerome Gilson, both of Brinks Hofer Gilson & Lione, and

Craig Morris facilitated the law firm session. Each group shared information about internal processes and how e-commerce will be integrated into their operations, and made numerous comments about using TEAS, including:

- More forms, e.g., Change of Correspondence address form, Express Abandonment form, and Change of Power of Attorney form, should be available on the TEAS site;
- Multiple specimen image attachments for a single class of goods should be possible;
- The Validation Page should be simplified to make the overall process more user-friendly;
- The “Downloadable Blank form” feature should be expanded to cover Intent-to-Use and Post Registration matters;
- Other types of image files besides gif and jpeg files should be accepted; and
- Space for entry of other nonstandard information; e.g., claim of use of a mark by a predecessor-in-interest, or use of a mark in another form, should be added.

The USPTO will carefully analyze this additional feedback to determine the viability of the suggestions, prioritize the implementation of the most feasible suggestions, and then enhance the site as soon as possible. Additional suggestions for how TEAS could better meet our customers’ needs are always welcome, and may be forwarded directly to [craig.morris@uspto.gov](mailto:craig.morris@uspto.gov).

Working together with our customers, we are confident that we will be able to capitalize on the outstanding opportunities that e-commerce brings to everyone. We will continue to strive to make changes that not only make sense for the USPTO, but for its customers as well. TEAS, from all indications, is such a change, since it helps promote efficient, effective, and timely processing of trademark applications. Since one of our primary goals is to ensure that the design of our electronic filing system meets the needs of our customers, the February Chicago event was a definite success, and should serve as the foundation for similar events across the country. In the meantime, we can only say, “We have built it, so now, please come.”

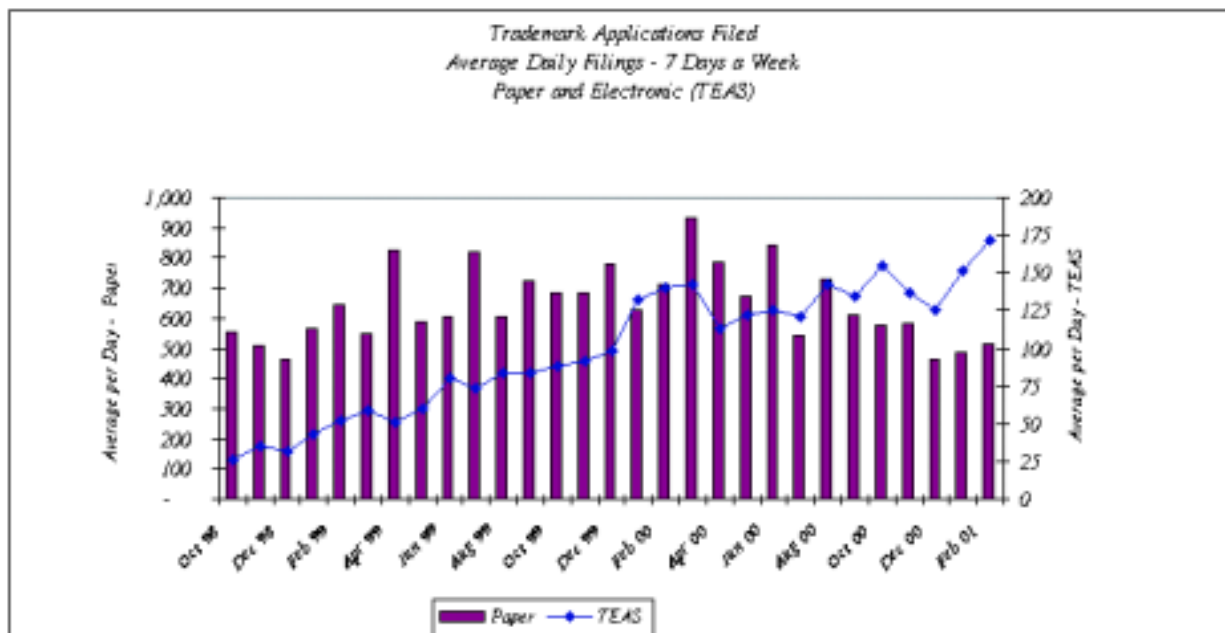
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## USPTO Seeks Customer Feedback to Enhance Trademark Electronic Filing

*by Craig K. Morris, Office of the Commissioner for Trademarks*

As the Internet and the World Wide Web gained acceptance as methods of business communication, some USPTO customers began asking for a trademark filing system that would fully use these technological advances. In response, the agency introduced the Trademark Electronic Application System (TEAS) as a pilot program, in November 1997, with about 50 customers.

Throughout the pilot, enhancements were made to TEAS, using pilot participants’ sugges-



tions. Satisfied with the pilot's success, on October 1, 1998, TEAS went worldwide, and the USPTO became one of the first national intellectual property offices in the world to offer an electronic filing system for trademarks.

TEAS allows the applicant to fill out an application form and check it for completeness over the Internet. Using e-TEAS, the applicant can submit the application directly to the USPTO over the Internet, paying by credit card or through an existing USPTO deposit account. Or using PrinTEAS, the applicant can print out the completed application for mailing to the USPTO, paying by check or money order or through an existing USPTO deposit account.

Since the inception of TEAS, the Trademark Operation has received more than 87,000 electronically-filed applications, and this number continues to trend upward. Electronic filing now accounts for approximately 21 percent of applications submitted to the USPTO. But to be considered successful, it is not sufficient for the Trademark Operation only to attract via TEAS new, one-time applicants for filing their trademark applications electronically. We must also see that our most important filers embrace TEAS. If, in fact, we see that traditional, large-scale "paper" filers begin using TEAS extensively, this will demonstrate that we have created a useful service for all filers, whether an attorney in a law firm, an in-house corporate attorney, or an individual applying without an attorney.

The number one overall filer of trademark applications, Mattel, Inc., now submits 80 percent of its applications via TEAS. Mattel began using TEAS as a pilot participant, and since that time, has steadily increased its use of TEAS. Clearly, it finds substantial benefits in electronic filing. If a corporation that previously relied so heavily on the paper filing system could successfully transition to TEAS, we are confident that other large filers will, in time, become part of the program. We will continue to look to such transitions as another way to evaluate the success of the TEAS program.

#### **Importance of Customer Buy-in**

Although we are convinced that electronic filing offers many benefits to our customers, improving both the quality of the initial application and the speed and accuracy in process-

ing submitted application data, we realize that it is critical that we do not share this view alone; that is, all of our customers must understand TEAS and its advantages. Part of being able to promote TEAS centers around gaining a better understanding of what our customers' needs really are.

In order to gain even more insight into what our customers want, last month we sent out a survey to 300 trademark filers that historically have submitted large numbers of paper applications to our office. The survey focused specifically on different aspects of electronic filing. Again, what we were most interested in learning was why our customers perhaps were not using the electronic filing system, and what enhancements could perhaps be introduced to change how these firms and corporations were doing business with the USPTO.

### **Survey Results**

The survey, conducted from January 19 through February 28, 2001, was mailed to 300 customers who traditionally are large "paper" filers, and who collectively accounted for 43,542 applications filed in 2000. In all, 31 percent of those selected responded to the survey. The survey was designed to gather indications regarding:

- .. Current methods of filing;
- .. Familiarity and expertise with e-TEAS;
- .. Types of e-filings currently being submitted;
- .. Reasons for not filing 100 percent electronically;
- .. Issues related to the signature aspect of e-filing;
- .. Expected changes in methods of filing; and
- .. Incentives USPTO could provide to increase the usage of e-TEAS.

While methods other than e-TEAS and PrinTEAS are used more frequently to file trademark forms, 52 percent of the respondents indicated that they had used e-TEAS at least one time over the past 12 months. This is encouraging given the infancy of the system. Twenty percent reported that they had filed more than 20 forms using e-TEAS. Usage of PrinTEAS was lower. Less than one quarter of respondents (21 percent) said that they had used PrinTEAS to file a trademark form, and the majority of these respondents had filed less than six applications via this method.

Customers are fairly familiar with e-TEAS for filing initial trademark applications and intent-to-use and post-registration submissions directly over the Internet. When asked how familiar they are with e-TEAS, 27 percent said to a moderate extent and 36 percent said to a great or very great extent. Customers are also generally satisfied with e-TEAS. Sixty-two percent rate their experience with e-TEAS as good or excellent. Of the applicants that had used e-TEAS more than five times, 71 percent reported having good or excellent experiences.

Roughly half (51 percent) of the respondents stated that they had filed an intent-to-use application electronically. Typed marks, submitted electronically by 44 percent of respondents, were the next most-popular type of electronic filing. Use-based marks and special form marks were filed by a similar number of respondents, at 27 percent and 25 percent, respectively.

For the most part, customers still feel their in-house templates are more efficient than those found in e-TEAS or PrinTEAS. Fifty-eight percent of respondents said this is one of the reasons they do not file 100 percent of their forms electronically. Survey participants also

said that the signature aspect of electronic filing is too cumbersome (cited by 44 percent). Respondents could cite more than one reason for not filing 100 percent of their forms electronically, and other frequently-mentioned reasons included the interface is not “professional” looking and it is difficult to produce or submit electronically-formatted specimens.

With regard to the signature aspect of electronic filing, 29 percent think the signature requirement should be eliminated entirely, and 25 percent vote for keeping it as it is now. Almost a third (30 percent) of respondents said that they are not familiar enough with the process to offer an opinion.

One of the most positive survey findings is that 60 percent of the top filers expect to increase their usage of e-TEAS over the next 12 months, and 25 percent intend on decreasing their usage of other forms. Thirty-six percent of the filers that have not used e-TEAS at all expect to try it sometime during the year. If realized, this computes to 69 percent of the top filers using e-TEAS to some degree. Respondents also provided suggestions on incentives or system changes USPTO could implement to increase the usage of e-TEAS even more. The suggestions that were mentioned the most included:

- “ Remove/lessen the signature requirements;
- “ Make it easier to submit drawings/specimens;
- “ Improve system reliability and/or confirmation of submissions so that users have more confidence in the system; and
- “ Reduce fees for electronic filings.

This survey data, as well as data that will be collected in the annual customer satisfaction survey, will be used by USPTO staff to identify system enhancements that will increase customer satisfaction and workload efficiency as the agency transitions to a dynamic e-commerce environment. USPTO would like thank the customers that respond to these surveys and take the time to help us better understand your needs.

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## Trademark Organization Charges Ahead With E-Filing

*by Rachel Wallace, Office of the Commissioner for Trademarks*

**T**he concept of electronic filing – or “e-filing” – has a resonance of the 1990s or the 21<sup>st</sup> century to it. Yet, it has been around for much longer than that. In fact, it emerged at the United States Patent & Trademark Office in the early 1980s, when then commissioner of patents and trademarks, Gerald J. Mossinghoff, recognized the need for change and proposed a far-reaching goal for the USPTO to become a paperless office. Unfortunately, early initiatives to move toward a paperless office did not succeed because they were limited to available technology that was not user-friendly.



Between 1992 and 1995, the Trademark Office explored various options for non-paper filing of trademark applications. Two pilot programs were tested: EASY (Electronic Application System) and TEDI (Trademark Electronic Data Interchange). The EASY program required submissions on floppy disks, and, according to participants, EASY, ironically, was too difficult to use. The other program, TEDI, was based on a file transfer protocol that customers found only marginally better.

The initiatives did not end with EASY and TEDI. The emergence of the Internet and the acceptance of the World Wide Web as a method of business communication eventually gave the Trademark Operation the proper tools to change how it did business. Responding to the rise of the Internet, the USPTO developed its current system, TEAS – the Trademark Electronic Application System. Like the two previous programs, TEAS was originally launched as a pilot, on November 30, 1997. Fifty customers participated in the pilot program, and the first application was filed almost immediately. On October 1, 1998, after the conclusion of a successful 10-month testing period, the USPTO opened TEAS worldwide at the Website, <http://www.uspto.gov/teas/index.html>. That opening made the USPTO one of the first national intellectual property offices in the world to offer an electronic filing system for trademarks. It also established the Trademark Operation as a leader in the area of electronic commerce and electronic government.

As a result, full electronic filing and processing has been part of the Trademark Concept of Operations for more than five years. Today, the Trademark Operation is fully prepared to promote the e-government/e-commerce concept by creating a single approach for serving customers that focuses on using information technology and the Internet.

### **The Importance of Electronic Filing**

The Trademark Operation is determined to meet the technological challenges of today. The USPTO is on a steady course to transition from paper-based processing and examination to electronic-based processing and examination. The aim of the Trademark Operation is to do more than change. It is to improve quality and customer service – in other words, to make things better. Although the current paper-based system functioned well in a marketplace restricted by time and space, to accommodate the 21<sup>st</sup> century global marketplace – the seamless market of e-commerce and global networks – the Trademark Operation must change the way it does business.

Aside from a determination to change for the better and to function in a new global market, there are 10 key reasons why the Trademark Operation must transition to electronic filing.

(1) It will improve customer service and the quality of information in the USPTO databases. Paper filings require a labor-intensive process, which has a high data-entry error rate. The volumes of paper generated lead to mishandled and lost filings. By contrast, data from TEAS is captured in structured formats, accelerating the process and ensuring that the data is transferred without errors. Also, electronic systems eliminate lost or missing papers. TEAS provides customers with greater assurance of meeting application-filing requirements and improves quality, because an automated validation function confirms whether all mandatory application fields have been entered. An application filed via TEAS receives a filing date of the day the application is transmitted to the USPTO, even if it is a Saturday, Sunday, or federal holiday. Further, the applicant immediately receives a confirmation of transmittal. Within 24 hours, he or she also receives an e-mail summary of his or her submission that will serve as the filing receipt for the application.

This type of response boosts customer satisfaction, and customer surveys show that electronic filers have a much higher satisfaction rate than paper filers.

(2) Electronic filing is necessary to handle continued increases in trademark application filings. The number of trademark applications filed with USPTO has increased dramatically in the past few years. For example, in fiscal year 2000, filings were up more than 27 percent from the previous year. Electronic filing would allow the USPTO to handle these ever-increasing workloads.

(3) Electronic filing would also enable the Trademark Operation to lower pendency. In fact, the greatest potential for performance improvement will come from reducing or eliminating the number of activities in the overall examination process, which in turn will reduce pendency. In the manual paper-based process, a new application must undergo multiple steps before it is ready for examination. Electronic filing increases the efficiency of examination and eliminates unnecessary steps and the movement of files. A large number of files are reviewed on petition to restore an earlier filing date due to mishandling mail or lost papers. Petitions to reconsider actions based on mishandled filings or responses will be nearly eliminated.

(4) Electronic filing would reduce staffing and space requirements. If the Trademark Operation continues to do business as it does today, it will have to add 12 additional law offices to the current 15 to process the level of filings projected for 2002. By 2006, it would need 56 law offices and a staff of 2,600. Compounding this problem, the Trademark Operation may not be able to rely on hiring more staff as a solution. The move toward smaller government mandates using other approaches. Electronic filing would reduce dependence on manual processes so that staffing increases in relation to filing increases are minimized. In addition, space would become less of a limited resource, because electronic processing would eventually permit elimination of paper files. This would allow the Operation to reduce and regain space for office expansion in support of application examination activities. Electronic filing and processing would also allow expansion of the work-at-home program, freeing up more office space.

(5) Electronic filing would increase access to the federal registration system. Although not mandatory, registration benefits business and consumers; therefore, helping more owners apply through a user-friendly process is critical. TEAS helps accomplish this by allowing all potential customers to easily find a trademark application form on the USPTO home page, complete it with comprehensive on-line help, and transmit it directly on-line. Even customers without Internet access can use computer systems at USPTO-affiliated and local libraries around the country.

(6) Electronic filing would help USPTO to control its costs. Receiving and storing data electronically provides the potential to reduce tremendously the costs associated with paper processes. Based on fiscal year 2000 costs, receipt of all information in an electronic format would have saved the USPTO \$10.3 million, which represents approximately 10 percent of its total costs for the year. Processing huge volumes of papers has an inherently large cost associated with it, because it is extremely labor-intensive and subject to error. Moreover, the cost is not always self-evident. For example, paper transactions require manual data entry, the finding of files, the matching of papers, the generating of filing receipts, and, often, the adding of later corrections to files. Electronic filing eliminates these steps and the costs associated with them.

(7) Electronic filing would help prepare USPTO for implementation of the Madrid Protocol. It is projected that the United States will join the Madrid Protocol before the end of calendar year 2001. The Madrid Protocol Implementation Act specifies administrative procedures to be followed by trademark applicants applying for international protection of trademarks. It is meant to simplify the process of applying for a trademark in multiple countries. USPTO will be prepared to receive all related filings and all payment of fees electronically.

(8) Electronic filing would fulfill the Trademark Public Advisory Committee (TPAC) directives. Last year, this newly reconstituted USPTO advisory panel was created. Consisting of nine voting members and three nonvoting members from USPTO unions, the TPAC advises the Trademark Operation on agency operations, goals, performance, and budget issues and user fees. In their first annual report to the president, the secretary of commerce, and the Judiciary Committees of the U.S. Senate and House of Representatives, the advisory committee endorsed mandatory electronic filing for trademark applications. It concluded that the USPTO should take immediate steps to replace paper-based processes and information with electronic processes.

(9) Electronic filing would enable USPTO to meet its performance goal. USPTO has committed to achieving measurable organizational goals and objectives in the performance agreement between the secretary of commerce and the Trademark Operation, including the integration of e-government into its business practices. The agreement sets forth that the Trademark Operation plans to receive 95 percent of applications filed electronically and communicate electronically in all communications with 50 percent of customers by 2003.

(10) Electronic filing would meet the new administration's commitment to move to e-government. Electronic filing is consistent with the Bush administration's campaign commitment to promote e-government as the way of bringing government services to all U.S. citizens. The USPTO is poised to meet that commitment. It has received, so far, over 83,000 trademark applications electronically, and, in the last quarter, the percentage of total applications being filed electronically rose to 24 percent. Moreover, the most recent customer survey conducted by the USPTO shows that customer satisfaction with electronic filing is very high. The Trademark Operation intends to continue to make enhancements to its electronic filing site to maintain and improve this level of satisfaction.

The USPTO is ready to meet the challenges and opportunities that face it and the trademark community. It has already moved into e-commerce and e-government. The reasons are plentiful, but the mandate is unique: the Trademark Office must change. To quote from a past USPTO Today article, "The Trademark Operation will continue to 'push the envelope' – but it won't be a paper one!"

## **The Components of Electronic Filing**

### **TEAS**

The origin of TEAS was described earlier in this article. TEAS is the hallmark of electronic filing at the Trademark Operation, because it is the one tool for applicants to file for trademark protection on-line. It provides direct and convenient access to a vast amount of critical information. It enables individuals to rapidly obtain an application form on the USPTO home Web page; complete the form; seek help either on-line or through contact telephone numbers provided at the site; transmit the application on-line; and pay by credit card or deposit account. This integrates the USPTO into the e-commerce world and

enables the public to conduct *all* of its business electronically, including the protection of intellectual property assets.

TEAS also has the capability to receive applications for marks consisting of a design and/or applications based on actual use. For these marks requiring submission of a sample of how the mark is being used in commerce (such as a label or an advertisement) and for those with designs, applicants can attach a file to the application in the GIF or JPG file format.

TEAS allows for electronic signatures. The signature on an application in TEAS can be any combination of alphanumeric characters placed between two forward slash symbols (/). For instance, /john smith/ or /js/ or /s123/ would all be acceptable. What is used as the signature is the choice of the applicant and requires no advanced approval.

In addition to filing first applications for trademark protection, on-line applicants can file renewal applications, §8 and §15 declarations, allegations of use, and requests for extensions of time to file statements of use. Once filed, TEAS sends these documents directly to the appropriate work unit.

TEAS provides for electronic data capture, which has improved the accuracy and efficiency of data processing. TEAS filings can be processed more quickly because data is submitted electronically, eliminating the need for manual data entry or capture by optional character recognition. These latter methods are labor intensive and error-prone. In fact, with paper applications, applicants periodically must request that the USPTO correct errors that are made during the original data entry, extending the time required for consideration of an application.

There are other benefits to TEAS, in addition to speeding up the initial processing time such as its simplicity. The public can easily access application forms and information on the Internet at any time. It is also easy to get technical assistance. Applicants can view help sections for each data field at the bottom of the Web screen, as well as access a wide variety of information about USPTO procedures and practice, thereby eliminating telephone calls. Also, individuals can e-mail questions to a TEAS Help Desk, which shortens response times. In addition, TEAS makes it possible to create tailored forms by eliminating irrelevant data fields through answering a series of “yes” and “no” questions in an initial form “Wizard.” The on-line form can be saved as a template for later use, eliminating the repetition of information.

Another benefit to TEAS is that once the application is completed, an automated validation function confirms that all information fields required for receiving a filing date have been entered. If the necessary information has not been provided, an error message is received. Although the other fields are optional for filing date purposes, the USPTO encourages customers to complete *all* fields for which necessary information is available, to avoid later delays in prosecution. TEAS does not, however, check the *validity* of information entered, nor does it perform any sort of search to see whether the mark is registrable. The assigned examining attorney performs these functions in the normal course of prosecution of the application. Nonetheless, the validation function improves the overall quality of applications and helps ensure that applications are not returned to customers for failing to meet application-filing requirements.

TEAS provides acknowledgment of receipt of an application. With a mailed application,

there is no way to immediately confirm receipt by the USPTO. Applicants usually do not receive an assigned serial number for several months. TEAS, however, provides within 24 hours a confirmation e-mail that includes the assigned serial number as well as a summary of the information entered in the application.

There is the added convenience of being able to file 24 hours a day, seven days a week. TEAS is based on the Internet, so the system is accessible almost 24 hours a day, 7 days a week, 365 days a year (there is a brief period, from 12:01 a.m. to 4 a.m. Sunday EST when credit card transactions cannot be processed). TEAS issues a filing date for the date in question up until midnight EST. Being able to file quickly and having up to seven extra hours before a filing date passes may be crucial. Using the paper system, filing dates may be lost if applications are not filed at the USPTO by 5 p.m. EST, or timely mailed via U.S. Postal Service Express Mail. If an application is filed after midnight EST, the filing date is the next regular business day. However, TEAS filing *could* be made on a day that the USPTO is closed (e.g., Saturday), and the USPTO will accord a filing date for that day, rather than the next regular business day.

Another advantage to TEAS is that it permits portability of the application form. Many attorneys are concerned about being able to obtain the signature of their client on an application because the client is in another city. Although the signature is not a filing date requirement, a verified application is required under U.S. law before an application can proceed to registration. The TEAS application is “portable,” which means that it can be filled out by the applicant’s attorney and e-mailed to the applicant for signature. It can then be returned to the attorney for filing at the USPTO. The portable form could also be used to save a template for doing multiple filings.

Finally, there is the financial benefit of cost savings on Express Mail postage and fax charges and/or courier delivery costs. By using TEAS, those who file many applications each year can cut out-of-pocket postage and/or fax expenses for filing each application by \$15 to \$20.

With all of these advantages, it is probably no surprise that surveys show TEAS applicants to be far more satisfied than paper applicants. One user told USPTO that TEAS was the “nicest interaction” she had ever had with the federal government. Another said that it “renewed his confidence in the government bureaucracy.”

Applicants are not the only ones who are satisfied with TEAS, however. Yahoo Magazine cited TEAS as one of the most useful sites on the Internet, and TEAS has been recognized for excellence in three recent national competitions. In May 2000, it was selected as a semifinalist in the *2000 Innovations in American Government Awards Program*, a competition sponsored by The Ford Foundation, The John F. Kennedy School of Government at Harvard University, and The Council for Excellence in Government. In October 2000, the USPTO learned that the panel of judges for the *2000 Government Technology Leadership Awards* had selected TEAS as one of this year’s winners. For the last eight years, the *Government Technology Leadership Awards* program has celebrated successful U.S. government initiatives that have directly aided the missions of their organizations by boosting efficiency and effectiveness, lowering costs, and/or improving service to the public through original uses of technology. In early January 2001, the TEAS program was selected as a semifinalist in the 2001 RIT/USA TODAY Quality Cup Competition, which recognizes teams who make significant contributions to the improvement of quality in their organization. Finalists and winners will be announced on May 11, 2001.

### **TESS**

TESS, or the Trademark Electronic Search System, is an electronic tool that would actually be used by an individual *before* using TEAS – in other words, before filing an application. TESS allows individuals to perform a search on the mark for which they want to apply for protection before actually filing the application. This could save them time and money by preventing them from applying for a trademark that someone else already holds. TESS provides the same information that is used by the examining attorneys to search marks. It is updated daily and is simple to use.

### **TARR**

The Trademark Application and Registration Retrieval (TARR) system comes into play *after* an application is filed through TEAS. Through TARR, applicants can retrieve information about pending and registered trademarks obtained from the USPTO's internal database by entering a valid trademark serial number or registration number – numbers that are assigned to an application after it has been received by the USPTO. The USPTO provides those numbers to applicants, enabling them to keep track of their files. In TARR, when either number is entered, information is immediately revealed about the type of mark, the current status of the mark, the date of the status, the filing date of the application, the current owner, the goods or services, and the prosecution history. This information is updated daily at 5:00 a.m. EST.

### **Trademark Electronic Business Center (TEBC)**

The Trademark Electronic Business Center is a single place on the USPTO Website that provides access to each of the above systems with explanations of each one. In sum, it provides everything an applicant needs for the entire registration process.

### **How to Learn More About Electronic Filing**

If the descriptions provided in the above section of the components of the Trademark Operation's e-filing initiatives leave questions to be answered, more information about electronic filing is available through:

**The USPTO Website:** The USPTO Website and, specifically, its link to the Trademark Operation (especially the TEBC), offer a wealth of trademark information. The public can now search the database for pending and registered trademarks, access materials containing information about the application process, fill out and submit a trademark application electronically, and obtain information on the status of applications and registrations. The Website also provides descriptions of the various e-filing systems, on-line help, and a list of frequently asked questions.

**Information Lines and the Trademark Assistance Center:** Applicants with further questions or concerns can contact the Trademark Office either through the USPTO toll-free information line (1-800-786-9199) or through its Trademark Assistance Center (TAC). In order to provide improved service to trademark applicants, registrants, and the general public, the USPTO implemented the TAC as a pilot program. The TAC is located at 2900 Crystal Drive, Room 4B10, Arlington, Virginia, 22202-3513. Assistance may be obtained in person or by dialing (703) 308-9000, Monday through Friday, 8:30 a.m. to 5:00 p.m. EST, except holidays. Personal assistance concerning both trademark and patent matters is also available at (703) 308-HELP. Recorded information is available at (703) 557-INFO.

**Lectures and Demonstrations:** On February 16, 2001, the USPTO presented “2001: The Trademark Office Goes E-Commerce” at the IIT Chicago-Kent College of Law in Chicago, Illinois. Commissioner for Trademarks Anne H. Chasser and Deputy Commissioner for Trademark Operations Robert M. Anderson spoke about the needs and strategies of the Trademark Office for transitioning to e-commerce. There was also a demonstration of TEAS and interactive discussions with corporate and law firm counsel on how e-commerce affects them. This presentation serves as just one example of the ways that the USPTO is using to instruct the public on its e-filing systems. Moreover, given the presentation’s excellent participation and success, it is likely to be the start of a round of similar lectures and demonstrations throughout the country. As with the USPTO Website and the TAC, these are great ways to learn more about electronic filing at the Trademark Office.

### **The Future of Electronic Filing**

At this point, it should be clear that the Trademark Operation has embarked on change involving cutting edge technology and futuristic thinking. The change will not end with the TEBC and with the TEAS, TESS, and TARR systems described earlier. The change has only just begun, and the Trademark Operation is moving even further into the future. The origin of that movement comes from the proposal of Commissioner Mossinghoff in the 1980s to make the USPTO into a paperless office. That proposal is now developing into reality.

In the performance agreement mentioned earlier, one of the main goals is to “integrate our business practices into e-government.” The performance initiatives that have been proposed to meet that goal include eliminating redundant paper systems and preferences for paper where automated systems have been established, proposing a rule change to make electronic filing mandatory for domestic filers, and developing a plan to transition all internal operations to support e-commerce. The first initiative is being achieved through the current e-filing systems.

The second, the rule change, has been proposed and submitted to the Office of Management and Budget, but it is on hold with the transition to the new presidential administration. The proposed rule would, as indicated, make electronic filing of all trademark documents currently available in TEAS mandatory. There would be two exceptions: (1) individuals without access to TEAS or without the technical capability to use TEAS, and (2) persons with citizenship, domicile, or a real and effective industrial or commercial establishment in a country other than the United States and whose country is a party to any convention or treaty relating to trademarks, trade names, or unfair competition, to which the U.S. is also a party, or extends reciprocal rights to nationals of the U.S. by law.

The third initiative is considered trademark business process reengineering. A new process model has been developed from input by teams of Trademark employees who perform the various tasks related to the processing of applications and from information gathered in focus groups held around the United States with applicants and their representatives. The model assumes the implementation of electronic filing; electronic data interchange between applicants, registrants, and the USPTO; and electronic files with a fully integrated electronic file management system. Every step in the application examination process – from accepting new applications to processing fee payments; to pre-examination procedures (the basic formalities check); to assigning applications for examination; to examination, publication, registration, and all post-registration activities – will be done electronically.

This will substantially improve customer service and quality, speed up the application process, and help the USPTO to handle large numbers of trademark applications without generating significant backlogs.

From its humble beginnings with the ideals of Commissioner Mossinghoff, electronic filing at the Trademark Office charges ahead. The Trademark Public Advisory Committee recognized its progress. In its Annual Report, it stated, “We compliment the leadership in the Trademark Office for their focus on the future and willingness to consider forward looking concepts of operation that are of great value to both the customers of the Agency who provide the funds for operations and to its employees who derive on-the-job satisfaction from these programs. We recommend these programs to the rest of the Government as an example for alternative ways of conducting business.”

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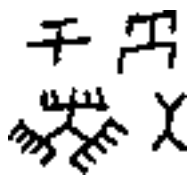
# Trademarks:

## Fingerprints of Commerce

*from the Patent and Trademark Museum and “Fingerprints of Commerce: An Educational Guide to Understanding the Importance of Trademarks”*

**T**rademarks are everywhere! In the medicine chest, in the closet, in the kitchen, in newspapers, in supermarkets, in restaurants, in shopping malls, on television and radio, on buses.

Everyday, each of us encounters about 1,500 trademarks. They help us know the source of a product or service and give us valuable information about quality and consistency. Trademarks are the foundation of competition for businesses and signify the freedom of choice to consumers.



Trademarks have been around a long time. Some have been found on pottery made around 5000 B.C.

**marks from Tordos, Transylvania**



Trademarks were used for different reasons in different parts of the world. Pottery makers in ancient China used marks as symbols of pride in their workmanship;

**example of Chinese porcelain mark from 57 B.C.**

Romans marked their utensils, food and wine, medicines, ornaments,



cloth, lamps, and bread; Egyptian and Roman masons marked their bricks for purposes of accountability if the building collapsed.



### Roman brick mark and mason's mark

In 1266, England passed a law requiring bakers to mark their bread so that "if any bread be faultie in weight, it may bee then knowne in whom the fault is." Silversmiths, goldsmiths, and other craftsmen also were required to mark their products.



As time went on and learning increased, trade expanded rapidly. Trade-marks became more important as preferences for particular products and workmanship began to develop. Marks of both the craftsman and his trade guild began to be applied: the maker's mark ensured accountability, while the guild mark showed the goods to be genuine.



### examples of printers marks



The Industrial Revolution meant more products could be machine made; manufacturing became more centralized and distribution improved. Consumers needed to know what was available and where, so the age of advertising began. Trademarks were a perfect way of quickly identifying a product anywhere it was sold.



### French and German porcelain marks

In 1791, a group of Boston sailcloth makers petitioned Congress to be allowed to register their marks. The matter was referred to Thomas Jefferson, then Secretary of State, who decided:

*"That it would, in his opinion, contribute to fidelity in the execution of manufacturing, to secure every manufactory, an exclusive right to some mark on its ware, proper to itself."*

*"That it will, therefore, be reasonable for the general government to provide in this behalf by law for those cases of manufacture generally, and those only which relate to commerce with foreign nations, and among the several States, and with Indian tribes."*

—Thomas Jefferson  
December 9, 1791

As the nation grew, so did the use of trademarks. Cattle farmers in the West branded their cattle in case they strayed or were rustled. Before logs were floated downstream to lumber mills, they were marked to establish ownership.



### Examples of brands and log marks



In 1870, Congress enacted the first U.S. trademark law. It was later declared unconstitutional because it was improperly based on the

patent and copyright clause in the Constitution. It wasn't until 1881 that a new law, based upon the commerce clause, was passed—just as Jefferson had suggested nearly a century before.

**W**hen you see this symbol, it means that the trademark or service mark is registered with the United States Patent and Trademark Office.



Federal registration of trademarks is not a requirement; however, it is advisable since federal registration accords the owner of a trademark certain advantages over unregistered marks. First and foremost the federal registration ® puts the world on notice that a trademark owner actually owns the mark and has exclusive rights to the use of it for particular goods or services.

Other advantages of federal registration include:

- ✓ The ability to use federal courts to prevent others from improperly using your trademark on their goods or services;
- ✓ The ability to receive up to three times your damages (called “treble damages”) if a party is found by a court to be improperly using or infringing on your mark;
- ✓ The ability to file applications for trademark registrations in other countries, based upon your U.S. registration; and
- ✓ The ability to prevent people and/or businesses from other countries from shipping goods into the United States that falsely display your mark on their goods.

These symbols are also used, usually before receiving a federal registration.

**TM SM**

### **Trademarks are not forever**

Once a trademark is registered, it can be renewed indefinitely if it is still being used in commerce. However, the owner must prevent the public from misusing the brand name to refer to all similar products. They do this by reminding the public, through advertising, that their brand names are trademarks and not just words. Some owners were unable to protect their marks after the public adopted them as common product names:

- ◆ aspirin
- ◆ corn flakes
- ◆ dry ice
- ◆ escalator
- ◆ high octane

- ◆ kerosene
- ◆ lanolin
- ◆ linoleum
- ◆ mimeograph
- ◆ nylon
- ◆ raisin bran
- ◆ yo-yo
- ◆ shredded wheat
- ◆ trampoline

## Buyer Beware!

Counterfeiting—the false marking of goods—has been a problem for centuries.

Trademark owners use criminal prosecution, policing infringers, and public education to discourage counterfeiting and infringement.

The international success of American products has led to a vast industry in counterfeit products. Product counterfeiting worldwide has cost America nearly \$200 billion and about 750,000 jobs.

## Recognize these names?

Famous people—especially entertainment or sports personalities—often use or license the use of their names as trademarks. The United States Patent and Trademark Office requires a signed consent before a name can be registered. Here are some samples from the USPTO archives:



## A world without trademarks?

If there were no trademarks, people would not be able to distinguish between the goods and services they like and those they dislike. Every object or service would be called for by the generic name, and we would have no way of distinguishing between those products that are good and those products that are not so good.

The main purpose of a trademark is to serve as a source indicator. A generic term identifies a type of product or service, without indicating any particular manufacturer or source. For example, “cola” and “soda” are generic terms, PEPSI and COKE are examples of

trademarks used to identify types of cola and soda. “Hamburger” is a generic term, BIG MAC and WHOPPER are examples of trademarks used to identify hamburgers which come from a particular source. “Sneaker” and “athletic shoe” are generic terms, NIKE and REEBOK are trademarks used to identify a particular type of sneaker or athletic shoe.

Can you match the following trademarks with the generic names for the goods? (answers below)

ROLLERBLADE	overnight courier service
COKE	Facial tissue
KLEENEX	Photocopier
XEROX	soft drink
FEDEX	in-line skates

A shooting star, or even a flying horse.... it’s more than a name, it’s recognition of a source! (The shooting star pictured in the Netscape logo is a registered trademark for on-line computer services and the flying horse, Phagesus, is a registered trademark owned by TriStar for motion picture services.)

So, before you open your wallet or your purse, remember trademarks: the fingerprints of commerce.



answers:

ROLLERBLADE is a registered trademark for in-line skates and is owned by Rollerblade, Inc.

COKE is a registered trademark for a soft drink and is owned by the Coca-Cola Company.

KLEENEX is a registered trademark for facial tissue and is owned by Kimberly-Clark Corporation.

XEROX is a registered trademark for photocopiers and is owned by Xerox Corporation.

FEDEX is a registered trademark for overnight courier services and is owned by Federal Express Corporation.

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## Trademark Services...

*A job well done!*

*by Anne H. Chasser, Commissioner for Trademarks*

**R**ecently, I stopped by the weekly meeting of the Trademark Services Group. Supervisors and managers from Pre-Exam, Assembly, Post Registration, Publication and Issue, Intent-to-Use, and the Trademark Assistance Center were all present, and Ron Williams, senior trademark administrator and acting director of Trademark Services, chaired the meeting. I was so happy that I just happened to stop by because I heard first hand how Trademark Services is striving to achieve our goals of enhancing the quality of our products and our services.

Trademark Services provides the first contact with our customers. Further, it provides integral support throughout the examination, registration, and post registration processes. I want to congratulate our staff for its commitment to customer service and its initiatives in minimizing our processing time. Let me share with you some of their recent accomplishments:

**Pre-Exam:** Robin Lewis and her staff are diligently working to upload accurate trademark application information onto our database and generate filing receipts within 14 days of the application being filed. In order to ensure the accuracy of the filing receipts provided to our customers, all of the information used to generate filing receipts is reviewed for accuracy before the information is uploaded onto the mainframe and filing receipts are mailed to our customers. We saw the number of days for the issuance of filing receipts drop from 107 days in March 2000 to nine days in September 2000.

**Assembly:** Michael Sykes and his staff in the Assembly unit have completely eliminated its backlog of over 45,000 files. Files are now delivered to the law offices within a few days. Outstanding accomplishment!

**Intent to Use:** Diane Douglas, our new supervisor, and the ITU [intent to use] staff are facing an ever-increasing workload. Seventy percent of our trademark applications are filed under the ITU provision. Intent to Use has reduced its backlog for processing SOU's [statement of use] and request for extensions of time from 100 days at the end of fiscal year 2000 to 33 days currently! The goal for processing SOU's and extension requests is 30 days. Congratulations to ITU!

**Pub and Issue:** Michael Macmillan and his staff continue to process increasing numbers of registration certificates, notices of allowance, and notices of publication. However, we are now beginning to transition into electronic publication of the *Official Gazette*. Electronic publication will afford us the opportunity to proofread the *Official Gazette* before it is published. Proofreading the OG, prior to publication, will save time and improve the quality of the OG, which should further improve customer satisfaction.

**Post Registration:** Shanna Webster-Trotman, Beverly Hilliard and their staff also face a tremendous increase in the number of renewal affidavits, Section 7 requests for amendments to registrations, and affidavits of use filed pursuant to Section 8. Post Registration is currently processing both 10 and 20 year renewals, which has essentially doubled their workload. With the additional staffing hired last year, we are expecting to achieve our goal of 30 days by the end of this fiscal year. Since October 1, 2000, the processing time in Post Registration has already been reduced from over seven months to less than five months. Good job! Post Registration.

Finally, our **Trademark Assistance Center**. Thanks to the leadership of Susan White and her mostly new staff in TAC, we have seen dramatic improvement to this important customer service operation. I'm happy to report that we have seen our service level improve from 27 percent in May 2000 to 70 percent as of March 15, 2001. This means that 70 percent of our customers are speaking to one of our customer service representatives within 20 seconds of the call reaching TAC. Our goal for this fiscal year is to achieve a service level of 80 percent.

Thanks to everyone in Trademark Services for your commitment to excellence!

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# An Interview with the Chairman of the Trademark Public Advisory Committee...

*Miles J. Alexander*

*Miles J. Alexander of Atlanta, Georgia, is senior partner in the Intellectual Property Group and chairman of Kilpatrick Stockton LLP. He is former counsel to the International Trademark Association.*



*by Jessie Marshall  
Office of the Commissioner for Trademarks*

**T**he Trademark Public Advisory Committee, or TPAC, was created by the 1999 American Inventors Protection Act to review the policies, goals, performance, budget, and user fees of the USPTO's trademark operations and advise the director of the USPTO on those matters.

I took the opportunity recently to ask the advisory committee chairman what he thinks about the challenges the Trademark Operation faces, the role of the advisory committee, and the office moving to an e-government environment.

**JM: How has the office changed since you first started practicing trademark law?**

MA: The most significant change I have seen in the area of intellectual property is the result of the rise of the Internet and the breakdown of nation-state borders. For purposes of intellectual property, it is a difference of a magnitude that is comparable to changing from horses and buggies to cars and airplanes. It's a quantum leap in terms of borderless protection from infringement.

**JM: What are the biggest challenges facing the Trademark Office?**

MA: I see the biggest challenges as conversion to an e-commerce model of communication, electronic filing of trademark applications, and the electronic availability of all records to the extent allowed by law.

**JM: In your opinion how can the public and the office work together to face those challenges?**

MA: In the context of the public, I believe the modernization of the USPTO and converting it from a paper to an e-commerce office will result in long-term cost savings to the public. Even more important, the office must continue increasing the quality of the services provided to the public.

**JM: How can the TPAC help the Trademark Office perform its function?**

MA: I think the TPAC has broad contacts among those who represent the public and the business community in filing applications for protection of trademarks. The TPAC can help facilitate educating filers both in the corporate sector and among the private bar to

convert to electronic filing and to enter the 21<sup>st</sup> century. That can be done by seminars such as the recent one in Chicago that came about through the joint efforts of educational institutions, the private trademark bar, and the USPTO. Those programs can be taken throughout the country to encourage the use of electronic filing by the public. The USPTO has done, I think, an outstanding job of preparing those presentations.

**JM: The new administration has made e-government a goal of all government agencies. How can TPAC help the Trademark Operation advance that goal?**

MA: I think our initial report focused on priorities that are consistent with not only the current administration's goals, but also with the past administration's goals. I don't think this is a political issue. I think it's an issue that is in the national interest of both the business community and the general public. Part of it involves mandating both electronic filings and record keeping as permitted by law. Another part is enabling the USPTO to become party to international treaties that are appropriate for us to adopt, such as the Madrid Protocol. And part of it involves appropriate funding for the USPTO so it can meet the mandate given to it.

**JM: In what areas do you see the TPAC advising the Trademark Office?**

MA: I believe TPAC consists of members with a broad range of experience in the corporate sector and private trademark bar sector. It includes members with management and trademark examining experience, including former USPTO examiners. That permits them to focus on everything from office responsiveness, budgetary priorities, TTAB matters, user needs, trademark examining corps and trademark office personnel issues, and expanded use of technology to the treaty, legislative, and rule-making issues.

**JM: What would you like to see the TPAC accomplish during your tenure as chairperson?**

MA: I think one of the primary goals of the TPAC needs to be assuring adequate funding of the USPTO through the dedication of user fees, without diversion, for purposes that permit the fulfillment of its mission. The USPTO is a performance based organization which is a relatively unique status and therefore should be given full access to all of its user fees.

**JM: What is your vision of the Trademark Office in five years?**

MA: I'm not sure that anybody can foretell the future; one can only have a wish list that would include: the USPTO becoming a fully vested member of the international community in the borderless world we find ourselves, that cutting edge technology exist throughout the USPTO operation at every level, that the quality and timeliness of its work products be at the highest level possible, and that the satisfaction of its employees and users serve as an example for other government agencies.

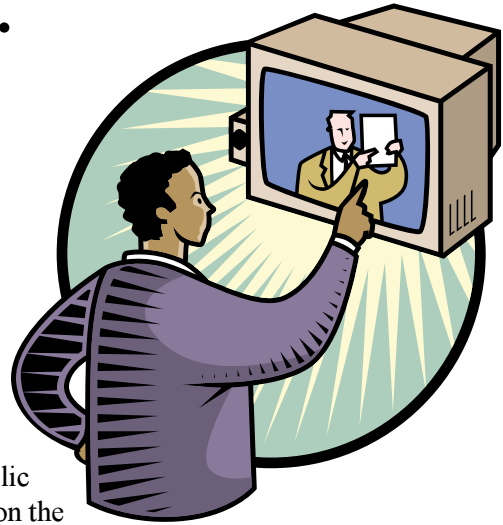
**JM: Is there anything else you would like to add concerning the TPAC or trademarks in general?**

MA: I believe that effective branding has become the most significant and recognized need of the business community in a competitive marketplace. At the very heart of the ability of our country to compete in the world is the ability of a business to establish reliable brands that communicate to the public and to others the quality image that is the foundation of all successful businesses. The USPTO performs a critical function in facilitating the establishment and protection of brands both domestically and internationally.

# Trademark Public Advisory Committee... Meets Via Teleconference... Embraces E-Government... Submits Annual Report...

*by Jessie Marshall, Trademark Administrator, Office of the Commissioner for Trademarks*

The Trademark Public Advisory Committee held its November 20, 2000, meeting via teleconference. This was the first time a public advisory committee meeting has used that technology, and it turned out to be quite successful. Members from all around the country were connected by telephone and USPTO representatives joined in through a telephone link from a USPTO conference room. There was also an open line for the general public to make contributions to the meeting or simply to listen in on the proceedings.



The first item on the agenda concerned a proposed Examination Guide that would liberalize the present policy concerning the identification of goods and services in trademark applications. The purpose of the change in policy is to simplify the crafting and presentation of goods and services thereby making both preparation and examination of applications more efficient. Presently, the identification of goods and services is questioned in about 75 percent of the trademark applications filed in the USPTO.

The Examination Guide attempts to balance the need to reduce the delay in processing applications by reducing the number of inquiries that are made in this area with the requirements of the Lanham Act to issue clear and accurate trademark registrations. After a lengthy and spirited discussion, the TPAC voted to endorse the Examination Guide with the recommendation that the guide be presented to the International Trademark Association and the American Intellectual Property Law Association as well as other interested groups such as NTEU 245, the union representing the trademark examining attorneys. The guide will be put out for public comment, changes made if necessary, and the final guide presented to NTEU 245 before implementation.

The chairman and other members of the committee expressed frustration over retention of USPTO fees. While it became clear that the committee was, understandably, in full support of the USPTO keeping all user funds to enhance the efficiency and quality of its functions, the members were at a loss to know what they could do to convince Congress of the need for retention of the funds in the USPTO. A discussion ensued in which the USPTO Office of General Counsel offered its advice concerning the activities that are or are not permitted by the TPAC charter. Clearly, lobbying as the TPAC or as an individual member of the TPAC is not permitted. But similar action taken as private individuals would be allowed. However, it was also indicated that there could be political implications

that should be taken into account, not in the least the position of the new administration concerning issues such as this. Further action was not clearly mandated, but the position of the TPAC was made manifest and that position, namely, the overwhelming need that the USPTO be able to retain all user fees for its own use, would be reflected in the TPAC report that would be sent to Congress.

The USPTO has proposed that filing trademark applications electronically using the eTEAS system be made mandatory. The electronic filings greatly increase office efficiency and assure accuracy in the applicant's information that is transferred electronically into the USPTO database. Commissioner Chasser indicated that mechanisms are being discussed for applicants that do not have access to or cannot use a computer for filing electronically as well as legal constraints that may be imposed by the Trademark Law Treaty or TRIPS. Members of the TPAC representing both large corporations and small individual applicants gave full support to the USPTO's efforts to make electronic trademark application filing mandatory.

On November 30, 2000, TPAC issued an annual report as required by the statute. The report included advice to the director of the USPTO on three major issues. (1) TPAC expressed concern that the agency does not have access to all user fees on a current basis; (2) concluded that to meet the demands of a dramatically increasing workload the agency should require electronic filing of new applications and other papers to the extent allowed by law; and (3) stated its belief that the benefits of joining the Madrid Protocol, an international agreement to facilitate the filing of trademark applications in multiple countries, would outweigh the costs of implementation at the USPTO.

For a copy of the Trademark Public Advisory Committee Annual Report for 2000, see the USPTO Web page at [www.uspto.gov](http://www.uspto.gov).

At the most recent TPAC meeting on March 1, 2001, USPTO officials and TPAC members discussed the budget, workload and performance of the USPTO's trademark operations. USPTO officials also reported on the status of various e-government initiatives, and the results of recent customer and employee satisfaction surveys.

The Trademark Public Advisory Committee was created by the 1999 American Inventors Protection Act to review the policies, goals, performance, budget, and user fees of the USPTO's trademark operations, and advise the director of the USPTO on those matters. TPAC members are U.S. citizens chosen to represent the interests of the diverse users of the USPTO. There are nine voting members, who are appointed by and serve at the pleasure of the secretary of commerce. The statute also provides non-voting membership for the agency's three recognized unions.

### **Members of the Trademark Public Advisory Committee:**

**Miles J. Alexander** of Atlanta, GA, is senior partner in the Intellectual Property Group and chairman of Kilpatrick Stockton LLP, a law firm that has over 450 attorneys. He is former counsel to the International Trademark Association.

**Helen M. Korniewicz** of Corte Madera, CA, manages the trademark group at the Chevron Corporation Law Department. In addition to foreign and domestic trademark and copyright issues, she is responsible for legal services for the e-commerce and communications activities of several Chevron entities and has extensive experience in commercial and consumer credit services.

**Susan C. Lee** of Bethesda, MD, is of counsel to the firm of Pena & Associates, P.C. and specializes in trademarks, copyrights, trade secrets, unfair competition, and internet law. From 1988-1993, she served as a trademark attorney with the United States Patent and Trademark Office, including representing the USPTO before the U.S. Trademark Trial and Appeal Board.



**David M. Moyer** of Terrence Park, OH, is the associate general counsel for trademarks and trade relations at the Procter and Gamble Company. He is also a past board member of the International Trademark Association.

*Trademark Public Advisory Committee from left: Miles Alexander, Chairman; Anne H. Chasser, Commissioner for Trademarks; Howard Friedman; Susan Lee; David Stimson; Helen Korniewicz; Griffith Price; Joseph Nicholson; John Rose; David Moyer; and Louis Pirkey.*

**Joseph Nicholson** of New York, NY, is a partner at Kenyon & Kenyon whose principal practice is trademark and unfair competition, including large international trademark portfolios. In addition to trademark practice, licensing and litigation, he has significant background in internet commerce and domain name issues.

**Louis T. Pirkey** of Austin, TX, is a member of the firm of Fulbright and Jaworski in Austin. He currently serves as the president of the American Intellectual Property Law Association and is adjunct professor of trademark law at the University of Texas School of Law.

**Griffith B. Price, Jr.** of Bethesda, MD, is a partner at the firm of Finnegan, Henderson, Farabow, Garrett & Dunner, L.L.P. He specializes in trademark and unfair competition matters. He is the former chair of the USPTO Public Advisory Committee for Trademarks, and the founding chair of the American Intellectual Property Law Association Trademark Law Practice Group.

**John T. Rose, II** of White Plains, NY, is vice president for human resources at ESPN. He previously served as senior vice president for player relations and administration for the NBA, where he was responsible for brand protection and trademarks worldwide, and organized an industry-wide task force on intellectual property protection. Prior to that, as vice president for law at NBC, he provided legal services on human resources, labor relations, finance, operations, and engineering matters.

**David C. Stimson** of Rochester, NY, is the chief trademark counsel for the Eastman Kodak Company. He has worldwide responsibility for Kodak's trademarks, including clearance, registration, oppositions, litigation, and licensing. He is a past president of the

International Trademark Association and has chaired INTA's Legislation, Finance, and Planning Committees.

**Virginia Cade** – area vice president for the trademark building and treasurer and steward of the National Treasury Employees Union (NTEU), Chapter 243, representing support staff. Ms. Cade is currently an applications classifier and has been with the USPTO for 28 years.

**Howard Friedman** - is president of the National Treasury Employees Union, Chapter 245, representing trademark attorneys in the Trademark Office, as well as attorneys at the Trademark Trial and Appeal Board. He joined the USPTO in 1993.

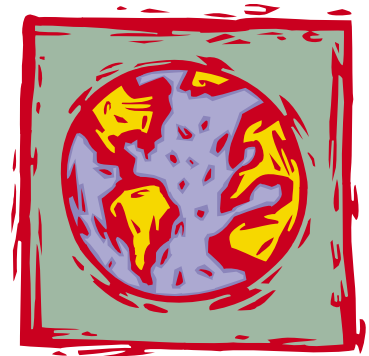
**Lawrence Oresky** – vice president of the Patent Office Professional Association (Union) for the past 18 years. Mr. Oresky is a patent examiner and joined the USPTO 30 years ago after obtaining a Masters Degree in Aeronautical Engineering from the University of Illinois.

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## IP Enforcement Activities

*by Elaine Wu, Office of Legislative and International Affairs*

Last year, the Office of Legislative and International Affairs (OLIA) here at the USPTO had a banner year particularly in the area of intellectual property (IP) enforcement. The year 2000 was a very productive and busy one for OLIA enforcement attorneys.



The USPTO provides guidance where appropriate to foreign governments and international intergovernmental organizations on matters of intellectual property protection. With regard to enforcement activities, the agency's role is essentially two fold: to monitor the implementation of bilateral, regional, and multilateral international agreements by foreign governments to ensure that they meet enforcement obligations and have effective IP enforcement systems, and to conduct and participate in numerous international enforcement training programs. OLIA has played a very major part in fulfilling both obligations.

OLIA enforcement attorneys were incredibly busy during 2000 in fulfilling their monitoring and legal analysis functions. As of January 2000, all developed and developing countries who are members of the World Trade Organization (WTO) were obligated to have domestic laws and enforcement mechanisms that comply with the international standards set forth under the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs). OLIA attorneys continue to analyze the IP laws of developing countries to ensure their TRIPs compliance. In addition, OLIA attorneys work with other government agencies to monitor the implementation and effectiveness of IP enforcement related laws in countries where such laws have already been established.

As for its international enforcement training activities, OLIA has been even busier. On an interagency level, OLIA participated in IP enforcement training programs initiated by the U.S. Department of State in Nepal. Other training programs included the IP Enforcement program, which OLIA offers twice a year on-site at the USPTO. This program, cosponsored with the World Intellectual Property Organization (WIPO), provides international participants with a week-long, in-depth program on developing a TRIPs compliant and effective enforcement regime.

Further, OLIA cosponsored with WIPO an Intellectual Property Border Enforcement program, which provided participants with training on TRIPs border enforcement standards and implementation options. In July 2000, OLIA again partnered with WIPO to provide law enforcement and other government officials from Africa with a week-long program in Dakar, Senegal on developing a TRIPs compliant and effective enforcement regime.

Recognizing the daunting challenges posed by the exponential growth in Internet usage the world over, OLIA turned its attention to enforcing intellectual property rights in cyberspace. In September 2000, the USPTO sponsored a two-day Symposium of the Americas in the Washington D.C. area dealing with the protection of intellectual property in today's digital environment. The program was designed to provide high-ranking government officials from international organizations, IP offices, and private industry in the Western Hemisphere countries with an opportunity to begin a dialogue on these issues and formulate an agenda for cooperation in the region. The program featured 51 speakers and 40 government officials and panelists from the Western Hemisphere and various organizations. Some 300 people from diverse countries throughout the Western Hemisphere attended the symposium.

Right on the heels of this regional symposium, OLIA attorneys sponsored, along with WIPO, a regional conference on protecting intellectual property in the Digital Age in Thailand that was geared toward the Asia Pacific region. Members of the International Trademark Association participated in both the Western Hemisphere and Thailand conferences. Then, in November 2000, OLIA attorneys flew to Taipei, Taiwan to sponsor a two-week judge and prosecutor's training seminar. The purpose of the seminar was to provide Taiwan judges and prosecutors with in-depth training on enforcement of intellectual property rights, and with nuts-and-bolts training on investigating and prosecuting trademark and copyright infringement actions.

Just a few weeks ago, OLIA attorneys participated in a successful symposium on the Internet and Intellectual Property Crime Symposium in London, England, sponsored by the USPTO and the United Nations Economic Commission for Europe, Advisory Group in the Protection and Implementation of Intellectual Property Rights (UN/ECE IP Advisory Group). The purpose of the three-day symposium was to serve as a forum for government and business leaders to meet and share their experiences and expertise in the enforcement of intellectual property rights, and to learn about the latest technological advances in the commission and investigation of intellectual property crimes. During the symposium, panels presented information on intellectual property crimes in cyberspace, conducting internet investigations, and privacy issues.

Finally, OLIA enforcement attorneys were involved in getting a new, statutorily created interagency group responsible for coordinating U.S. domestic and international intellectual property enforcement activities. This group, called the National Intellectual Property Law

Enforcement Coordination Council, or NIPLECC, coordinates both domestic and international intellectual property activities. The Under Secretary for Intellectual Property cochairs the council with the Assistant Attorney General, Criminal Division. Other members include the Undersecretary of State for Economic, Business and Agricultural Affairs; the Deputy United States Trade Representative; the Commissioner of Customs; and the Under Secretary of Commerce for International Trade. OLIA plays a pivotal role in working with the other agencies to define NIPLECC's mission and to identify challenging IP enforcement issues, such as combating internet infringement, that it could partner with industry and rights holders to address.

OLIA enforcement attorneys expect the rest of the year 2001 to be as busy as last year with a proposed IP enforcement program in Vietnam. In addition, OLIA is working on two proposed IP enforcement programs in Russia and the Ukraine, both in cosponsorship with the UN/ECE IP Advisory Group. Both proposed programs will likely be designed to focus on law enforcement issues as well as issues relevant to registration of IP rights, successful business methods, and government-industry cooperation in enforcement and public awareness areas. OLIA will also continue to host its annual IP enforcement and border programs again this year here at the USPTO.

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## Helpful Hints

for trademark applicants



## *Top Ten Tips*

for Filing and Prosecuting a Trademark Application

### **1. Use TEAS to File a Trademark Application Online**

Trademark applications filed electronically using the Trademark Electronic Application System (TEAS) at <http://www.uspto.gov> are processed much faster than paper applications filed by mail or hand delivery. The USPTO receives an application filed electronically using TEAS within seconds after filing, and immediately issues a confirmation of filing via e-mail. If all the requirements of filing are met, the filing date is the date the USPTO receives the transmission, regardless of whether that date is a Saturday, Sunday, or federal holiday within the District of Columbia. TEAS is available 24 hours a day, seven days a week.

## **2. Use the On-line Manual of Acceptable Goods and Services**

Trademark applications must include a list of goods and/or services. Applicants can choose from the vast number of identifications in the Acceptable Identification of Goods and Services Manual (Good/Services Manual) to describe their goods and/or services.

The Goods/Services Manual is available online at <http://www.uspto.gov>. TEAS applicants can access the Goods/Services Manual by clicking on a hyperlink located on the TEAS applications.

## **3. Submit Specimen(s) with a Use-Based Application**

If you are using your mark in commerce and you file an application based on that use, you should file specimen(s) with your application. A specimen is an actual example of how you are using the mark in commerce on or in connection with the identified goods and/or services. For example, you may submit a label for the goods or a photograph that shows the mark on the goods, or a brochure or advertisement for the services that includes some reference to the type of services rendered.

A complete application based on use in commerce must include a specimen for each class of goods and/or services identified in the application for which use in commerce is claimed. Because the examination of an application is not complete until the specimen(s) are submitted, an applicant should file the required specimen(s) with the application.

## **4. Make Sure the Application is Complete and Accurate**

The submission of a completed USPTO standard application form will help avoid the unnecessary delays that may result from the omission of application requirements. The USPTO form is available online through TEAS at <http://www.uspto.gov>. TEAS applicants are provided with online help sections to assist in the completion of each section of the application and a validation function that reviews the application for accuracy and completeness before it is transmitted over the Internet.

The printed USPTO standard application form may be obtained by calling the Trademark Assistance Center at 703-308-9000 or 800-786-9199. The Trademark Assistance Center also provides assistance in the completion of the application form.

## **5. Conduct a Search of the Trademark Database**

You *should* search the USPTO records before filing an application to determine if any party is already claiming rights in a particular mark. You may conduct a search online using the USPTO Trademark Electronic Search System (TESS) at <http://tess.uspto.gov>.

## **6. Use TEAS to File Trademark-Related Documents**

In addition to filing an application for registration of a trademark or service mark, an applicant may use TEAS to file an amendment to allege use, a statement of use, and a request for extension of time to file a statement of use. TEAS may also be used by the owner of a trademark registration to file an affidavit of continued use under 15 U.S.C. §1058, an affidavit of incontestability under 15 U.S.C. §1065, a combined affidavit under

§§1058 and 1065, or a combined filing under 15 U.S.C. §§1058 and 1059.

## **7. File Timely Responses and Documents**

During the prosecution of an application, you may be required to respond to an office action or official notice within a prescribed time period. You must file a proper response to the action or notice within the prescribed time period to avoid the abandonment of the application.

The filing date of a document is the date of receipt in the USPTO, not the date of deposit as mail. For documents filed electronically using TEAS, the filing date is the date of receipt regardless of whether that date is a Saturday, Sunday, or federal holiday within the District of Columbia. For documents (excluding trademark applications) filed by mail or fax, use of a certificate of mailing or transmission is encouraged to avoid lateness due to mail delay or receipt in the USPTO *after* normal business hours. *See* Rule 1.8, 37 C.F.R. §1.8.

## **8. Inform the USPTO of Address Changes**

You must keep your mailing address current with the USPTO. If your address changes at any time during the application process, you must request a change of address in writing. The request should include the applicant's name, the application serial number and the mark and be addressed to:

Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202

## **9. Periodically Check the Status of the Application**

You should expect to hear from the USPTO within a few months of filing an application for registration or trademark-related document. If you do not receive a written action or telephone call from the USPTO within a reasonable time of filing a document, then you should check the status of the application through the Trademark Applications and Registrations Retrieval (TARR) database on the USPTO web site at <http://tarr.uspto.gov>. You should also check the status of the application every six months during the prosecution of your application.

If the status inquiry indicates that there is a problem with your application, you should contact the USPTO to request corrective action immediately.

## **10. Inform the USPTO of Change in Name or Ownership**

Only the owner or the owner's legal representative may file and prosecute a trademark application. When an applicant changes its name or assigns the application to another party, the applicant (or new owner) should file the name change or assignment for recordation in the Assignment Division of the USPTO and notify the appropriate office within the Trademark Operation. Notification of the recordation of a name change or assignment will avoid unnecessary delays in the prosecution of the application and will help ensure the issuance of the certificate of registration in the name of the proper party.

# Faces of the USPTO

## **An Interview with Lynne G. Beresford Deputy Commissioner for Trademark Examination Policy**



*by Rachel A. Wallace, Office of the Commissioner for Trademarks*

**T**he Trademark Operation is in the forefront of the age of electronic commerce and electronic government, it is constantly and actively searching for new ways to improve its customer service and the quality of its products and services, and it has been involved in major efforts to harmonize trademark laws throughout the world. The Trademark Law Treaty and the Madrid Protocol Implementation Act are the most recent examples of this.

Lynne Beresford, deputy commissioner for trademark examination policy, has been an important participant and a driving force in these trademark initiatives. Rachel Wallace, presidential management intern in the Office of the Commissioner for Trademarks, recently interviewed Lynne Beresford about her role in trademarks, its focus on providing outstanding customer service, and high quality products and services... and more.

**RW:** Tell me a little about your career here at the USPTO and, specifically, within the trademark area. How do you see your role within trademarks?

**LB:** Actually, I came here in 1979. I was clerking for a judge at the U.S. Tax Court. I graduated from law school in 1977, worked for a year at the Tax Court, and then came here as an examining attorney. I worked as an examiner for six years, during which time I was president of the union and negotiated one of the basic contracts. Then I became a managing attorney. After that, I became trademark legal administrator. Then I went to OLIA (the Office of Legislative and International Affairs). Finally, I came here. I've really had a chance to do everything. The job never gets boring. It's been fun!

**RW:** What is your role currently?

**LB:** I am in charge of trademark examination policy. Right now, the staff, led by Mary Hannon and helped by attorneys from many areas of the office, is working through a revision of the *Trademark Manual of Examining Procedure*. We're also looking at areas where new exam guides would be useful. I also have responsibility for post-registration and for the staff of the commissioner's office.

RW: Providing excellent customer service and high quality products and services are important goals of the Trademark Operation. What steps are being taken by the Trademark Operation to improve the quality of trademark examination?

LB: Updating the TMEP, of course, will provide better information to examining attorneys. The staff is also working on a procedural manual for people who do amendments and process post-registration papers and intent-to-use papers. So, the plan is to standardize our processes and our legal standards throughout the organization. In addition, Sharon Marsh and I are working with the Office of Quality Review to enhance what they do for the office, make their work more of a teaching experience for the office, and use their work to improve examination quality. I have some responsibility for examination quality and hope that working with the Office of Quality Review will ultimately improve the quality of examination.

RW: What methods are being used by the Trademark Operation to provide trademark examination policy to the public?

LB: All of our guides, manuals, etc. are on our Web site. This includes the ID Manual, the Manual of Examining Procedure, the Rules of Practice, Trademark Law, Basic Facts, and more. We disseminate a number of products that the public uses. We just updated *Basic Facts About Registering Trademarks*. We send out literally thousands of copies of that every year, and it tells people what they need to know about filing a trademark application. So, we have all kinds of things that we're doing to educate the public.

RW: There has been a great deal of talk and enthusiasm about global harmonization of intellectual property laws. What harmonization initiatives are being undertaken by the Trademark Operation?

LB: Well, in terms of harmonization, international harmonization is really the work of the Office of Legislative and International Affairs. The United States joined the Trademark Law Treaty after it was adopted in 1994, and that treaty harmonizes procedural handling of trademark applications. The real harmonization of trademarks, though, is a long way off, because there are many, many things that countries would have to agree on. Basically, there are two kinds of systems in the world. There are variations of deposit systems and examination systems, and it is hard to harmonize those two types of systems.

RW: You mentioned the *Trademark Identification Manual*. The manual is currently being updated to help resolve issues regarding the identification of goods and services in trademark applications. What are the recommendations for changing the manual, and how will these changes impact examiners and applicants?

LB: Jessie Marshall is expanding the number of ID's that are in the manual. Of course, everyone hopes to also make it more user-friendly and accessible on-line. The rule within the Trademark Operation is that if the identification comes directly out of the identification manual, and it actually describes goods and services, then the examining attorney should accept that identification. By expanding the ID manual, the USPTO will be giving applicants many more choices on the ID menu, and so there should be more and more identifications that come into the office that will automatically be acceptable. That would make the examining attorney's life easier and the applicant's life easier.

We're hoping to some day be able to have a database that is very easy to use where the

examiner will be able to just click on the electronic application file and it will tell him or her whether the ID is directly out of the manual. They won't have to page through a manual. They won't have to search. They will be able to do it automatically. But we're not there yet.

RW: Like the rest of the USPTO, the Trademark Operation is moving forward into e-government and e-commerce. Will this move alter examination policies, and if so, what major changes in policy will occur as a result of the e-government/e-commerce initiatives?

LB: Almost everything done as part of examination is driven by our statute. Unless that changes, there won't be many changes in policy. There are going to be certain changes, of course, in procedure. As we become more electronic, we will be communicating with our applicants electronically. There will be some changes in how we archive and how we save information. And, of course, we'll eventually have electronic files instead of paper files. Those changes will make differences in procedure and how we operate. However, without changes in the statute, policy will evolve, but major policy changes probably will not come.

RW: We've already talked about policy changes. What are some of the biggest policy challenges facing the Trademark Operation within the near future? What are your thoughts about how it should face those challenges?

LB: The pressure caused by the rise in the number of applications is making us look carefully at everything we do. We want to be as efficient as possible in examination. All of our policies are being reevaluated. Our examination – even our statute – is being scrutinized so that only what really adds value to the trademark application and to the registration process is retained. That's a process that's ongoing. The other thing that's going to face us, if we join the Madrid Protocol, is that we'll have a number of issues to solve on how to integrate the Madrid application into the U.S. application filing stream. And I'm sure that as we operate the Madrid system here in the United States, a number of policy issues will arise related to Madrid. We're trying to solve as many as possible in advance with legislation and regulations, but I'm sure some other things will arise.

RW: Tell me a little about the Office of Quality Review. How does it work with trademarks to improve the quality of trademark products and services?

LB: The Office of Quality Review is an independent office, and they do a very fine job of reviewing a large number of trademark application and registration files every year. They look for errors in substantive examination and procedural examination. We're working with them, hoping that they will be able to give us bulletin or memo-type feedback on a monthly or biweekly basis as to the kinds of trends they're seeing in error rates or particular errors that suddenly seem to be surfacing. We're really in the very early stages of discussing it. But I think they have such a good over view of what the Operation is doing in terms of quality, and the people in that office are so experienced that the examining operation must use that experience to help us raise our quality.

RW: Do you have any final thoughts that you would like to share about trademark policy?

LB: It's never been uninteresting! I think because the world is changing so much, and because of the pressure brought on by domain names, by Madrid, by other forces that we are going to have to deal with, it's going to remain a very interesting and lively area.

The American Intellectual Property Law Association recognized the contributions of the following trademark examining attorneys “to the integrity of intellectual property law while in distinguished service at the United States Patent and Trademark Office.” AIPLA president, Lou Pirkey, presented the certificates during the association’s annual meeting in October.

***Karen Bush*** received her undergraduate degree from the University of Notre Dame and her law degree from the University of Pittsburgh. She began her career with the Trademark Office in 1989. Over the years she has handled many different classes of goods and services as well as handling special marks. Karen has also lectured on many substantive and procedural issues to fellow examining attorneys as well as the outside bar. Outside of the office she enjoys playing with her two children and swimming competitively through the U.S. Masters swimming program.



***Jodi Lauterback*** attended Boston College where she earned degrees in German and Psychology. She received her law degree at St. Mary’s School of Law in San Antonio. Ms. Lauterback came to the USPTO in November of 1995 and has demonstrated an outstanding level of performance very year since. She recently began participation in the work at home program and even more recently has enjoyed the birth of her son Tyler on March 17, 2001.



***Patrick Shanahan*** has been with the Trademark Office, as an examining attorney, since November 1990. He is an experienced attorney in Law Office 113, one of the few offices that focuses on the examination of the more difficult trademark applications for computers and telecommunications related goods and services. Mr. Shanahan has been part of the very successful Trademark Work at Home pilot program since September 2000.

He has a wonderful wife of over three years and a beautiful two-year-old daughter, Jordan. The family recently moved to Leesburg, VA.

In his free time, Patrick plays “over 30” baseball and enjoys working around the house and taking walks with his daughter.

**Patrick Shanahan**  
Law Office 113  
10 years of service

photo not available

## Trademark Business Goals

- Enhance the quality of our products
- Enhance the quality of our services
- Minimize our processing time
- Implement e-government into our business process
- Enhance employee satisfaction

**Our story is a simple one:  
We stand for QUALITY.**

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